V.f.

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EXAMINER	
ART UNIT	PAPER NUMBER
1209	7

12M2/0107

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DATE MAILED: 01/07/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 10/9/96 ☒ This action is made fi

A shortened statutory period for response to this action is set to expire 3 month(s), ____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-9
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 15-24 are pending in the applicati

Of the above, claims _____ are withdrawn from consideratio

2. ☒ Claims 14 & 25-44 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 15-24 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been receive ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Status of Claims

1. Claims 15-24 are pending in this application. Claims 14 and 25-44 have been canceled.

Response to Arguments

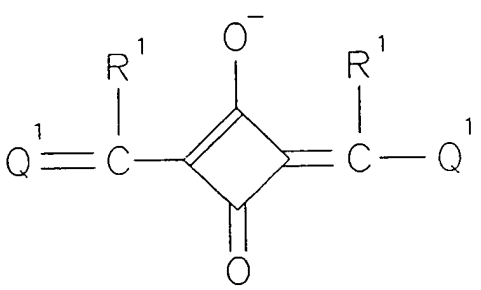
2. Applicant's arguments filed 10/9/96 have been fully considered but they are not persuasive.

3. The objection to claim 22 because of stated informalities is hereby withdrawn in view of Applicants' amendment to the claim.

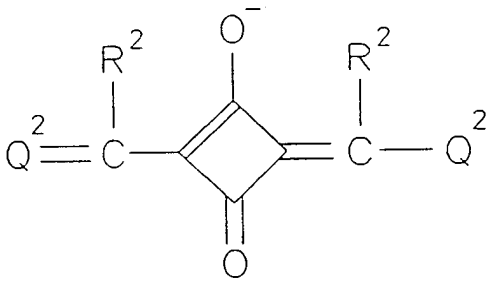
4. The rejection of claims 16-23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention stands for the reasons of record and the following.

Applicants argue that in *Marosi*, the Court decided that in the claimed process the Applicants could include the language in the claim "a silicon dioxide source *essentially free* from alkali metal." The facts of Marosi refer to a chemical process wherein the starting materials contain essentially no alkali metal and therefore the final product obtained from the claimed process also contain essentially no alkali metal. Applicants attempt to correlate the fact situation of the present case to that of Marosi by stating that they have devised a synthesis which enables asymmetric dyes to be produced essentially without contamination by the corresponding symmetric dyes and hence should be able to claim the resultant, essentially pure dyes which, to the best of their knowledge, has not been and cannot be prepared by the prior art synthesis, which

inevitably produces a tertiary mixture. Applicants are claiming the product, i.e., the compounds of formula (I), not a product-by-process. Therefore, the reliance on the Marosi case appears to be misplaced. Since the present claims are directed to compounds of formula (I), a person skilled in this art would interpret this claim to include compounds wherein Q^1CR^1 and Q^2CR^2 are different, therefore it would be redundant to state that the compounds of formula (I) are essentially free of compounds of formulae:



and



In addition, the above formulae read on compounds of the present invention since claim 15 states Q^1 and Q^2 are each independently a pyrylium, thiopyrylium, selenopyrylium, benzpyrylium, benzthiopyrylium or benzselenopyrylium nucleus, and R^1 and R^2 are each independently a hydrogen or an aliphatic or cycloaliphatic group. One can envision that Q^1 at each occurrence is different or Q^2 at each occurrence is different, R^1 at each occurrence is different, or that R^2 at each occurrence is different, since Q^1, Q^2, R^1, and R^2 are independently selected.

Claims 15-19 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gravesteijn et al. (US 4,508,811) for the reasons of record and the following. Claims 15-21 and 23-24 are rejected under 35 U.S.C. § 103 as being unpatentable over Katagiri et al. (US

5,079,127) for the reasons of record and the following. Applicants state that none of the references alone or in combination teach a person having ordinary skill in the relevant art how to prepare the asymmetric dyes of the present invention essentially free from the corresponding symmetrical dyes as required by the present claims. The claims present herein are directed to the squarylium compounds, not a process of preparing the compounds. Further, Applicants admit that the compounds could be prepared by the prior art process yielding a mixture of three products and that the prior art does not disclose how to separate the mixture. Gravesteijn et al. and Katagiri et al. each teach compounds wherein Q^1 and Q^2 of Applicants formula (I) is different. In addition, Applicants have failed to provide evidence that the process of the prior art or a modified process of the prior art would not produce the asymmetric dyes. Further, since in a patent it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere allegation that it is possible to operate within the disclosure without obtaining the alleged product. It is to be presumed also that skilled workers would as a matter of course, if they do not immediately obtain desired results, make certain experiments and adaptations, within the skill of the competent worker. The failures of experimenters who have no interest in succeeding should not be accorded great weight. **Bullard v. Coe**, 1945 C.D. 13, 64 USPQ 359; **In re Michalek**, 1974 C.D. 458, 74 USPQ 107, 34 CCPA 1124; **In re Reid**, 1950 C.D. 194, 84 USPQ 478, 37 CCPA 884.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner M. Cebulak whose telephone number is (703) 308-4520.

mcc

January 6, 1997

JOSE' G. DEES
SUPERVISORY PATENT EXAMINER
GROUP 1200